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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/944,691	08/31/2001	Kairi Ann Johnston	10017724-1	2138

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EXAMINER

GRANT II, JEROME

ART UNIT

PAPER NUMBER

2626

DATE MAILED: 02/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/944,691	JOHNSTON ET AL.
Examiner	Art Unit	
Jerome Grant II	2626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### **Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 22 December 2005.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 1-3,5-33,35-43,45-50 and 52-58 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) 1-3, 5-31, 45, 46, 48-50 and 52-56 is/are allowed.

6)  Claim(s) 32,33,35-43,57 and 58 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**JEROME STANTON II**  
**PRIMARY EXAMINER**

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.

5)  Notice of Informal Patent Application (PTO-152)

6)  Other: \_\_\_\_.

**Detailed Action**

1.

The final rejection mailed 9-20-2005 is withdrawn for the reasons set forth in the arguments by applicant.

Claims 1-3, 5-33, 35-43, 45-50 and 52-58 are pending.

Claims 1-3, 5-31, 45-46, 48-50 and 52-56 are allowed.

Claims 32, 33, 35-43, 57 and 58 are rejected.

2.

**Rejection Under Sect. 101**

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The claimed invention lacks patentable utility. The utility of the method is not set forth in the claim.

The claimed invention, according to claims 32-43 and 58, lacks patentable utility. It describes a method but it is not clear what the method steps will function to achieve or perform.

3.

**Rejection Under Section 112**

Claims 32-43 and 58 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The examiner will maintain the position that claims 32-43 and 58 are maintained as rejected under section.

In the telephone conversation of December 22, 2005, the examiner relied upon 35 U.S.C. 100(b) and 37 C.F.R. 1.75 (e)(1) in support for the position taken.

Applicant argued that neither of these sections address the incorporation of the utility into the preamble.

However, as applicant cited, section 100(b) states in part:

**” The term ‘process’ means process, art or method ... an includes a new use of a known process, machine...”**

Applicant has failed to recite a new use of a known process in the method claim.

This would make clear what the method described in the claim is used for.

Furthermore, applicant argues that Rule 1.75 (e) (1) is not a requirement.

Applicant is correct, however, the rule is a guide to what applicants' **should** do.

Having not submitted claims that meet the definition of Section 100(b), applicant has clearly not complied with Section 101.

4.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5.

Claims 57 and 58 are rejected under 35 U.S.C. 102(e) as being anticipated by Kumpf.

With respect to claim 57, Kumpf teaches an imaging system as shown by figure 1, comprising: a component configured to generate a scanned image preview (via the preview button on the client scanner interface according to col. 7, lines 1-5). Kumpf teaches image data corresponding to an image, the scanned image preview representing the image in electronic form (image file directory according to col. 8, lines 48-54 and 62-66); an image region section control (user interface) configured for manipulation to select an image region (col. 7, lines 15-17) of the scanned image preview (col. 7, lines 18-20); the component further configured to emulate a final scan of the image region to generate a final scanned image, see col. 7, lines 14-22) and an image region definition control configured for manipulation to define a classification of the image region, the parameters including paper size, image type, resolution, color or grey-scale, according to col. 5, lines 47-53.

With respect to claim 58, Kumpf teaches an imaging method, which is performed by the apparatus of figure 1, comprising the steps of: generating a scanned image

preview (via the preview button on the client scanner interface according to col. 7, lines 1-5). Kumpf teaches image data corresponding to an image, the scanned image preview representing the image in an electronic form (image file directory according to col. 8, lines 48-54 and 62-66; defining an image region by means of image region section control through the user interface for manipulating to select an image region, see col. 7, lines 15-17; and emulating the final scan of the image region to generate a final scanned image (see col. 7, lines 14-22).

## 6. Examiner's Remarks

At the bottom of page 14 of applicant's remarks, applicant states that Kumpf does not disclose an imaging system in a region or portion of a scanned image selectively chosen and retained. But applicant correctly points out that Kumpf teaches carrying out a preview scan (see col. 7, lines 1-13) and selecting a portion of the scan (col. 7, lines 18-19). The retention of the preview image is executed given that it is stored on a disk according to col. 6, lines 30-35.

At the top of page 15, applicant argues that Kumpf does not disclose or suggest a classification of a selected image. The examiner contends that the classification referred to is paper size, image type, resolution, color or grey scale, according to col. 5, lines 47-53. The selection of the image region is executed by the user interface, see col. 7, lines 15-17. Applicant further argues that Kumpf does not suggest emulating a

final scan from a selected preview scan. The examiner does not agree. The examiner contends that col. 7, lines 14-22 explains this portion of the emulation of the final scan. Correction data is used on the selected image and the corrected data is then used upon the entire image from that which has been previewed.

With respect to claim 58, applicant contends the sections relied upon by the examiner regarding the preview scan to emulate a final scan are not provided by col. 7, lines 14-22; col.8, lines 48-54; 62-66 and col. 7, lines 1-5. These sections explain a user selecting a portion of a down loaded image. A portion of the image is saved on disk, see col. 6, lines 30-35. See also figure 7 for an illustration of the selection of a downloaded image for processing. The results of the process are applied to the entire downloaded file.

Applicant further contends, that claim 58 should be allowed since claim 46 is allowed. However, claims 46 is directed toward a computer readable medium for implementing the steps of the method. This is not shown by Kumpf.

7.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerome Grant II whose telephone number is 571-272-7463. The examiner can normally be reached on Mon.-Thurs. from 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly A. Williams, can be reached on 571-272-7471. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

J. Grant II JEROME GRANT II  
PRIMARY EXAMINER